



13 NOV 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Jessica R. Wolff
Brobeck, Phleger & Harrison
12390 El Camino Real
San Diego, California 92130

In re Application of
BRIGGS et al.
Application No.: 09/463,542
PCT No.: PCT/US98/15411
Int. Filing Date: 24 July 1998
Priority Date: 25 July 1997
Attorney Docket No.: 015110.0085.UTL
For: HUMAN PEROXISOME
PROLIFERATOR ACTIVATED
RECEPTOR GAMMA.....

DECISION ON PETITION

This is a decision on applicants' "Request for Withdrawal of Notification of Abandonment under 37 CFR 1.181" which is being treated as a Petition under 37 CFR 1.181 filed in the Patent and Trademark Office (PTO) on 21 December 2001.

BACKGROUND

On 24 July 1998, applicants filed international application no. PCT/US98/15411 which claimed a priority date of 25 July 1997. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 25 January 2000.

On 21 January 2000, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application and a preliminary amendment.

On 15 March 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a one (1) month period for response. The notification was mailed to the attorney of record listed on the 21 January 2000 Transmittal Letter.

On 25 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 15 March 2000 within the time period set therein. The

Notification of Abandonment was mailed to the attorney of record listed on the 21 January 2000 Transmittal Letter.

On 13 October 2000, applicants filed a Status Inquiry Letter. In a communication dated 29 November 2000, the PCT Legal Office responded to applicant's status request indicating that the above-identified application was abandoned. The notification was mailed to Brobeck, Phleger & Harrison, 12390 El Camino Real, San Diego, California 92130.

On 06 September 2002, applicants filed "Change of Correspondence Address" and "Request for Withdrawal of Notification of Abandonment."

DISCUSSION

Petitioner asserts that the delay in responding was caused by nonreceipt of the Notification of Missing Requirements dated 15 March 2000. A review of the written record indicates that the Notification dated 15 March 2000 was addressed to the correspondence address on file as of 15 March 2000 and indicates no irregularity in the mailing of the Notification. In the absence of any irregularities there is a strong presumption that the Notification was properly mailed to the address of record and this presumption may be overcome by a showing that the Notification was not in fact received. The showing required to establish the failure to receive an Office action must consist of a statement from the practitioner stating that the Office action was not received by practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Applicants state in their present petition that, "[a]pplicants' representatives moved their offices Lyon & Lyon . . . to Brobeck, Phleger, & Harrison . . . throughout February and March of 2000. Correspondence was forwarded from Lyon & Lyon to Brobeck, Phleger, & Harrison as a routine matter. But applicants' representative did not receive the Notification of Missing Requirements that was mailed by the Patent Office on March 15, 2000." Applicants' counsel has attested that the Office action was not received by the practitioner and that a search of the file jacket and docket records indicates that the Notification of Missing Requirements was not received. Applicants' representative has provided a copy of a docket record, however, it is unclear if the docket record is for Lyon & Lyon or Brobeck, Phleger, & Harrison. Additionally, a review of the application papers reveals that a change of correspondence address was not filed for the present application until 06 September 2000. Section 601.3 Change of Correspondence Address, Manual of Patent Examining Procedure states, "[w]here an attorney or agent of record changes his or her correspondence address . . . a separate notification must be filed in each application for which a person is intended to receive communications from the Office." Applicants have failed to show that a proper change of correspondence address was filed prior to 15 March 2000 or show that the Notification mailed 15 March 2000 was not received at the address of record detailed above.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
Legal Examiner
Office of PCT Legal Administration



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Facsimile: 703-308-6459